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In re Application of
Vanderbauwhede, Boxho, and
Macq
Application No. 09/729177
Filed: December 05, 2000
For: METHOD AND DEVICE FOR
ECHO CANCELLING

:
:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

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OFFICE OF PETITIONS

This is in response to the "Petition Under 37 CFR §1.47(a)," filed on April 20, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on December 5, 2000, without an executed oath or declaration and naming Vanderbauwhede, Boxho, and Macq as joint inventors.

Accordingly, on February 20, 2001, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on April 20, 2001, the instant petition and a declaration of facts of Caroline Heyndrickx were filed. Ms. Caroline Heyndrickx states that the Declaration and Power of Attorney and the Assignment paper were sent to Mr. Macq for execution along with a copy of the English application but the papers were returned by UPS Courier. In addition, a "Declaration and Power of Attorney" signed by inventors Vanderbauwhede and Boxho was filed. The \$130.00 petition and the \$130.00 surcharge were also filed with the petition.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an

acceptable oath or declaration in compliance with 35 U.S.C. §115 and §116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (4) set forth above.

As to item (1), the petition states that inventor Macq is no longer employed by the assignee and has refused to execute the required formal papers due to a dispute as to the terms of departure. The declaration of facts of Ms. Heyndrickx, however, indicates that the papers which were sent to Mr. Macq for execution were returned and Mr. Macq cannot be located. Accordingly, it is unclear whether Rule 47 applicant is seeking to obtain Rule 47 status on the basis that the non-signing inventor cannot be reached or on the basis that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers.

Rule 47 applicant has failed to show that the inventor cannot be reached. It appears from the declaration of facts of Ms. Heyndrickx and the copy of the UPS Express mailing label attached thereto that the papers for Mr. Macq's signature were sent to the assignee's business address. The petition indicates that Mr. Macq no longer works for the assignee. Simply mailing the application papers to a business address at which Mr. Macq no longer works and having such papers returned is insufficient proof that the non-signing inventor cannot be located. Ordinarily, the last known address is the last known residence of the non-signing inventor.

In addition, Rule 47 applicant has also failed to show or provide proof that the inventor has refused to sign the declaration after having been presented with a copy of the application papers. While the petition indicates that the inventor has refused to execute the formal papers, no details regarding the alleged refusal have been provided. It is also unclear whether the inventor was presented with a copy of the application papers (specification, including claims, drawings, and oath or declaration) prior to the alleged refusal. The circumstances of the refusal must be specified in an affidavit or declaration of facts by the person to whom the refusal was made. See MPEP 409.03(d).

A copy of the application papers should be sent to the last known address of the non-signing inventor with a request that he sign the declaration. Petitioner should show that a copy of the application papers was presented to the inventor, but that he did not respond to the request that he sign the oath/declaration in order to show the inventor has refused to join in the application. Alternatively, if the papers are returned as undeliverable with no forwarding address, then applicant may be able to establish that the inventor cannot be reached. In that case, an affidavit or declaration of facts should be submitted that fully describes the exact facts relied on to establish that a diligent effort to locate the nonsigning inventor was made. A copy of the envelope showing that it was undeliverable should be

submitted as documentary proof.

As to item (4), a statement of the inventor's last known address is required. It is noted that the declaration of facts of Ms. Heyndrickx states that "[w]e do not have another address of Mr. Macq and he left Alcatel without leaving his home address." An address for Mr. Macq has been provided in the declaration under 37 CFR 1.63 but it is unclear if this is Mr. Macq's last known address. As noted above, the last known address is ordinarily the last known residence of the non-signing inventor.

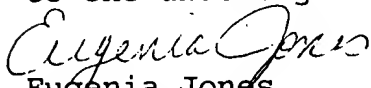
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
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By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Four, Suite 3C23
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Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5586.



Eugenia Jones
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